

SUBJECT: DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM

DATE: 1/6/03

APPL. S.N.: 09,800,887

TO EXAMINER: Quarb

ART UNIT: 1636

ROOM _____

MAILROOM DATE 12/23/02

AFTER FINAL YES _____ NO X NUMBER OF T.D(S). FILED 1

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.

- ☒ The T.D. is PROPER and has been recorded. (See 14.23).
- ☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).
- ☐ The recording fee of \$ _____ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)
- ☐ Application Examiner has not processed T.D. fee. (See fee authorization).
- ☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).
- ☐ The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).
- ☐ It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).
- ☐ The person who signed the terminal disclaimer:
- ☐ has failed to state his/her capacity to sign for the business entity, (See 14.28).
 - ☐ is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).
- ☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel⁴ and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). **NOTE:** This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).
- ☐ No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).
- ☐ The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.
- ☐ Attorney not of record in oath/decl, or a separate paper filed appointing a new or associate attorney. (See 14.29.01).
- ☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).
- ☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).
- ☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)
- ☐ Other: _____
- _____
- _____
- ☐ Suggestion to request refund of \$ _____. (See 14.35, 14.36).

☐ **EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALTIES MAY BE FAXED IN TO THE GROUP**

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

- ☐ Sample of a TD over a pending application and assignee Certificate (See 14.37).
- ☐ Sample of a TD over a prior patent and assignee Certificate (See 14.38).
- ☐ Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)



PATENT
Customer No. 22,852
Attorney Docket No. 06478.1441.01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Claude NÉGRIER et al.) Group Art Unit: 1636
)
Application No.: 09/880,887) Examiner: Ngyen, Quang
)
Filed: June 15, 2001)
)
For: MODIFIED FACTOR VIII cDNA)
)

#10

Commissioner for Patents
Washington, DC 20231

Sir:

TERMINAL DISCLAIMER

Assignee, AVENTIS BEHRING GmbH, duly organized under the laws of Germany and having its principal place of business at Postfach 1230, D-35002 Marburg, Germany, represents that it is the assignee of the entire right, title and interest in and to the above-identified application, Application No. 09/880,887, filed June 15, 2001, for MODIFIED FACTOR VIII cDNA, in the name of Claude NÉGRIER et al., as indicated by the assignment duly recorded in the United States Patent and Trademark Office at Reel 010634, Frame 0575 on March 16, 2000. Assignee, AVENTIS BEHRING GmbH, further represents that it is the assignee of the entire right, title and interest in and to U.S. Patent No. 6,271,025, as indicated by the assignment duly recorded in the United States Patent and Trademark Office at Reel 010634, Frame 0575 on March 16, 2000.

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12/24/2002 SSESHE1 00000005 09880887

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To obviate a double patenting rejection, assignee hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,271,025, Assignee hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, Assignee does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that the prior patent later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or in part, is terminally disclaimed under 37 C.F.R. § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

In accordance with the fee schedule set forth in 37 C.F.R. § 1.20(d), the required fee of \$110.00 is being filed with this disclaimer.

If a check for the required fee is not filed concurrently herewith or if there are any additional fees due in connection with the filing of this Terminal Disclaimer, please charge the fees to our Deposit Account No. 06-0916. If a fee is required for an

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extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to Deposit Account No. 06-0916

The undersigned is an attorney of record in this application.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 23, 2002

By: 
Carol Einaudi
Reg. No. 32,220

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